

REMARKS

The present amendment is in response to the Office Action mailed December 1, 2001 in the above-identified application. Enclosed herewith is a petition requesting a three month extension of time for extending the deadline for responding to the Office Action from March 1, 2002 to and including June 1, 2002.

The Examiner rejected claims 43, 50, 53-54 and 59 under 35 U.S.C. § 112, second paragraph as being indefinite. As noted above, claims 43 and 53-54 have been cancelled, thereby rendering the rejection moot with respect to those claims. Claims 50 and 59 have been amended. In view of the above-noted amendment of claims 50 and 59, Applicants respectfully assert that claims 50 and 59 now satisfy the requirement of 35 U.S.C. § 112, second paragraph, and are otherwise allowable.

The Examiner rejected claims 40-48 and 52-57 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 267,265 to Meyer in view of U.S. Patent 5,339,716 to Sands et al. Referring to FIG. 1 thereof, Meyer discloses a cutter for paper and cloth including a knife "o" that slides within a guide, the knife being actuated by a lever "i" and rod "k" linkage. Referring to FIG. 9 thereof, Sands discloses a miniblind cutter having a ratchet handle 40 that is pulled to move a cutting blade 31 horizontally toward a miniblind secured against a backup 44. The cutting blade 31 cuts in series through a bottom rail 134, slats 136, and a top rail 132. The Sands device, however, is not designed to simultaneously cut through the bottom rail 134, slats 136 and top rail 132. Thus, Sands actually teaches away from the present application which recites claims directed to simultaneously cutting through the "bottom rail, the slats and the head rail of said window covering."

Applicants respectfully assert that the Examiner has failed to consider the claimed invention as a whole. In

determining the differences between prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. MPEP 2141.02. Discovering a source or cause of a problem is part of the "as a whole" inquiry. Clearly, the present invention recognizes the problems that occur when too much force is exerted upon a bottom rail and a head rail of a window shade during a cutting operation, e.g., see Applicants' Disclosure at page 3, lines 4-9. Specifically, the present invention recognizes that too much force exerted upon the head rail and bottom rail will cause the items to crack. As noted by the CCPA, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103. *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is clear that neither the *Sands* nor *Meyer* references discuss the problem noted in Applicants' disclosure. Applicants assert that the "cracking" problem is part of the "subject matter as a whole" and indicates the unobviousness of the claimed invention.

Applicants also respectfully assert that claim 40 is unobvious because the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Clearly, *Meyer* and *Sands* provide no suggestion that the references be combined to meet the limitations set forth in claim 40.

Applicants also respectfully note that the modification proposed by the Examiner cannot change the principal of operation of a reference. As set forth in the MPEP, "If the

proposed modification or combination of the prior art would change the principal of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01. As such, it is impermissible to add *Sands* to *Meyers*, because the addition would change the principal of operation of *Meyers*, i.e. *Sands* moves horizontally in only one axial direction while *Meyers* teaches moving the blade along multiple axes at the same time.

As such, Applicants respectfully assert that claim 40 is unobvious over the combination of *Meyer* and *Sands* because the cited references neither disclose nor suggest a system whereby "said cutting surface, said clamping assembly and said cutting surface are arranged so that the cutting edge of said cutting blade simultaneously engages and cuts through the bottom rail, the slats and the head rail of said window covering." Claims 41-42 and 44-48 are allowable, *inter alia*, by virtue of their dependence from claim 40.

Claim 52 is allowable for the reasons set forth above with respect to claim 40. Claims 55-57 are allowable, *inter alia*, by virtue of their dependence from claim 52.

The Examiner also rejected claims 49-50 and 58-59 under 35 U.S.C. § 103(a) as being unpatentable over *Meyer*, in view of *Sands*, and further in view of U.S. Patent 245,330 to Walker. Referring to FIGS. 1-3 thereof, Walker discloses a paper cutting machine including a support A, a bed B for supporting paper BB, a knife C for cutting the paper, a guide D for guiding movement of the knife C, and a clamp G for holding the paper BB stationary during a cutting operation. In operation, a handle F is pulled for rotating toothed involute E, which in turn, engages the teeth on the back of knife C. Walker's novelty relates to the knife traveling "endwise six times as far as downward." This is an improvement over cutting machines where

the knife "moves endwise only about the same distance as it moves down." Col. 3, lines 14-23. Walker's disclosure provides no teaching or suggestion that knife C has a "pocket." In fact, Walker makes absolutely no mention of the shape or dimensions of the knife. Claim 49 is unobvious over the references cited by the Examiner because the references neither disclose nor suggest that the "cutting blade includes a pocketed portion that is thinner than a massive portion of said cutting blade that surrounds the pocketed portion, and wherein the cutting edge of said cutting blade is confined entirely within the pocketed portion of said cutting blade." Claim 58 is unobvious for the same reasons set forth above with respect to claim 49. Claims 50 and 59 are unobvious, *inter alia*, by virtue of their dependence from claims 49 and 58, respectively.

The Examiner also rejected claim 51 under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Sands, and further in view of U.S. Patent 5,103,702 to Yannazzone. Referring to FIG. 1 thereof, Yannazzone discloses a stop block 32 that is moved away from an end of slat 16 before commencing a cutting operation. Yannazzone does not teach or suggest, however, that the "stop block" is "linked with said driver for moving away from said window covering during a cutting operation." Clearly, Yannazzone's stop block 32 is removed by hand and is not linked with a driver that also drives a cutting assembly. Yannazzone also teaches away from the claimed invention because it teaches that the stop block is moved away before the cutting operation commences. Col. 2, lines 3-15. For all of these reasons, claim 51 is unobvious and is otherwise allowable. Claim 51 is also unobvious by virtue of its dependence from claim 40, which is unobvious for the reasons set forth above.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment.

The attached page is captioned "Version with markings to show changes made."

As it is believed that all of the objections, rejections and requirements set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.


If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted

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Version With Markings to Show Changes Made

40. (Amended) An apparatus for cutting a window covering including a head rail, a bottom rail and slats extending between the head rail and the bottom rail, said apparatus comprising:

a base having a substantially flat cutting surface;

a frame overlying said cutting surface and mounted to said base, said frame and said cutting surface defining a receiving area therebetween for receiving said window covering;

said base including a clamping assembly adapted for securing the bottom rail, the slats and the top rail of said window covering in a side-by-side arrangement atop said cutting surface so that the bottom rail, the slats and the top rail are in contact with the substantially flat cutting surface;

a cutting assembly including a cutting blade having a cutting edge mounted to said frame for sliding along a movement axis toward and away from said receiving area, said movement axis having a first component of movement extending in a direction substantially parallel to said cutting surface and a second component of movement extending in a direction substantially perpendicular to said cutting surface; and

a driver connected with said cutting assembly for imparting sliding motion to said cutting assembly for moving said cutting blade along the movement axis toward said receiving area, wherein said cutting surface, said clamping assembly and said cutting assembly are arranged so that the cutting edge of said cutting blade simultaneously engages and cuts through the bottom rail, the slats and the head rail of said window covering.

50. (Amended) The apparatus as claimed in claim 49, wherein only the ~~massive-pocketed~~ portion of said cutting blade ~~does not engage~~ the bottom rail, the slats and the top rail of said window covering during a cutting operation.

52. (Amended) An apparatus for cutting a window covering including a head rail, a bottom rail and slats extending between the head rail and the bottom rail, said apparatus comprising:

a base having a substantially flat cutting surface;

a frame overlying said cutting surface and mounted to said base;

said base including a clamping assembly adapted for securing the bottom rail, the slats and the top rail of said window covering in a side-by-side arrangement atop said cutting surface so that the bottom rail, the slats and the top rail are in contact with the substantially flat cutting surface;

a cutting assembly including a cutting blade having a cutting edge mounted to said frame for sliding along a movement axis toward and away from said cutting surface, said movement axis having a first component of movement extending in a direction substantially parallel to said cutting surface and a second component of movement extending in a direction substantially perpendicular to said cutting surface; and

a driver connected with said cutting assembly for moving said cutting blade along the movement axis toward said cutting surface, wherein said cutting surface, said clamping assembly and said cutting assembly are arranged so that the cutting edge of said cutting blade simultaneously engages and cuts through the bottom rail, the slats and the head rail of said window covering, and wherein the cutting edge of said cutting blade remains substantially parallel to said substantially flat cutting surface when engaging and cutting through the bottom rail, the slats and the head rail of said window covering.

59. (Amended) The apparatus as claimed in claim 58, wherein only the ~~massive-pocketed~~ portion of said cutting blade ~~does not engage~~s the bottom rail, the slats and the top rail of said window covering during a cutting operation.

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